

REMARKS

Applicant has carefully considered the Office Action of October 7, 2005 and offers the following remarks to accompany the above amendments.

The specification was objected to for a few informalities. Specifically, a serial number was missing and punctuation was not proper. Applicant herein amends the specification to provide the missing serial number and punctuation as well as correct a few other typographical errors. No new matter is added, but the specification is now in better form. Applicant requests withdrawal of the objection to the specification at this time.

Claims 10 and 27 were objected to for a few informalities. Applicant herein corrects "send" to "sent" and provides the appropriate termination for claim 10. Applicant requests withdrawal of the objection to claims 10 and 27 at this time. Applicant also amends the majority of the claims to fix typographical errors, clarify antecedent bases, and otherwise improve the readability of the claim set. No new matter is added.

Claims 1, 17, 25, and 26 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Patent Office asserts that elements (b)(ii) of claims 1, 17, and 26 as well as element (c) of claim 25 are unclear. Applicant respectfully traverses.

The Patent Office asserts that this should be construed to be merely "sending subscription-based content to subscribers of the content." While this interpretation captures the essence of the claim language, it does omit a key component of the claim language. Specifically, the claim recites "periodically". Thus, the sending of the claim occurs periodically. In light of this further clarification, the Patent Office's interpretation is correct. Applicant requests withdrawal of the § 112 rejection of claims 1, 17, 25, and 26.

Applicant adds new claims 28 and 29 which correspond to claims 9 and 27 without the "means plus function" language of the original claims. No new matter is added. As noted above, Applicant pays for the additional claims through the enclosed credit card form.

Claims 1-6, 9-14, 17-22, 26, and 27 were rejected under 35 U.S.C. § 103 as being unpatentable over Ricci in view of Ferguson et al. (hereinafter "Ferguson"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove that there is a suggestion in the art to combine the references. To prove that there is a suggestion in the art to combine the references and to confirm that the Patent Office is not relying on impermissible hindsight reconstruction, the Patent Office must do two

things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If the Patent Office has not provided actual evidence to support the prove the suggestion to combine the references, then the Federal Circuit's instructions in *Dembiczak* hold that the combination is improper.

Applicant initially traverses the rejection because the Patent Office has not provided the required evidence to prove the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is "because charging users and content providers a fee would greatly increase profitability of the file sharing service" or "because charging marketing content providers a fee would greatly increase profitability of the file sharing service." (Office Action of October 7, 2005, page 4, lines 8-9; page 4, lines 16-17; page 5, lines 12-13; or page 6, lines 20-21). This asserted motivation has no evidence to support the allegations contained therein. That is, there is no evidence that increasing the profitability is desired, and further there is no evidence that charging users and content providers and/or marketing content providers increases profitability. Rather, the double charge might increase the cost to the customer so much that the customers no longer purchase the product and drive profitability down. Since the Patent Office has not been able to prove that the suggestion was present in the prior art and the Patent Office has not been able to prove that the combination creates the alleged profits, the combination of references is improper, and a rejection based on the combination is improper.

For claims 3, 11, 19, 26, and 27, the Patent Office provides a different, but equally unsupported, motivation to combine the references. Specifically, the Patent Office asserts that the motivation would be "because paying owners of the affiliate servers would increase retention of the affiliate server owners." (Office Action of October 7, 2005, page 5, lines 4-5 and page 7, lines 1-2). This asserted motivation lacks any evidence to show that increasing retention of affiliate server owners was desired in the prior art. Further, this asserted motivation does not prove that the combination actually increases retention of the affiliate server owners. Thus, the Patent Office has not properly supported this motivation to combine the references, and the rejection based on the combination is improper.

Applicant further notes that Ricci actually teaches away from subscription services. While Ricci does teach a registration process at paragraphs 0057 and 0061, paragraph 0032

indicates that an object of the invention is to collect royalties without charging subscription fees. Thus, Ricci actually teaches away from the combination. If a reference teaches away from the combination, then the combination is non-obvious.

Even if the combination is proper, a point which Applicant does not concede, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

The independent claims 1, 9, 17, 25, and 26 all recite "charging a fee based on a quantity of content served. . ." or some close analog to this element. The Patent Office asserts that the element is taught by Ricci, paragraphs 0022 and 0053. Applicant traverses this assertion. Paragraph 0022 states in full: "[0022] In accordance with a further object of the invention, the method insures that even an anonymous user downloading a file will pay the owner the appropriate royalty." While this passage indicates that the user will pay the owner, the fee is based on the appropriate royalty due the copyright owner. The fee is not based on the quantity of the content (see paragraphs 0027 and 0031). Thus, this paragraph does not teach or suggest that the fee is based on the quantity of the content. Likewise, paragraph 0053 states in full: "[0053] The server also can include a royalty database. The royalty database includes the costs of licensing the digital media, the limits of the license (i.e., duration, number of uses) and relates the royalties to the recipients database to track which recipients have licensed which digital media." Again, this passage describes royalties for copyrighted works, but these royalties are not a function of the quantity of the content served. Thus, neither passage teaches the claim element. The Patent Office points to nothing in Ferguson which cures the deficiencies of Ricci. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness.

Claim 3, 11, and 19 deserve special mention. These claims recite paying owners of the affiliate servers a percentage of the fee charged for serving the content. The Patent Office admits that Ricci does not teach this element, but asserts that it is taught by Ferguson, col. 9, lines 2-9. While the cited passage of Ferguson does indicate that users of the system may be paid, there is no indication that these users are affiliate servers. Paying the users as taught by Ferguson does not equal paying the owners of the affiliate servers as recited in the claims. Thus, Ferguson does not teach the element for which it is cited, and Ricci admittedly does not teach the element.

Since the references individually do not teach or suggest the element, the combination cannot teach or suggest the element, and the combination does not establish obviousness.

Claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Ricci in view of Ferguson and further in view of allegedly admitted prior art. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not cured the deficiencies of the combination of Ricci and Ferguson. That is, as explained above, the combination of Ricci and Ferguson is improper for multiple reasons. Even if the combination is proper, a point which Applicant still does not concede, the combination does not establish obviousness. The addition of the allegedly admitted prior art does not cure these issues.

Applicant further traverses the rejection because the Patent Office has not provided any motivation to combine the allegedly admitted prior art with the combination of Ricci and Ferguson. Assuming, *arguendo*, that the fee based on a cost per click or cost per acquisition is known, there is no reason to combine this attribute with Ricci and Ferguson. Merely because the elements are all present in the prior art does not mean that there is a motivation to combine the elements in the manner claimed. Since the Patent Office has not shown why the allegedly admitted prior art would be combined with Ricci and Ferguson, the combination is improper and the rejection is improper. Applicant requests withdrawal of the § 103 rejection of claims 7, 8, 15, 16, and 23-25 at this time.

Claims 1-27 were also provisionally rejected under the judicially created doctrine of obviousness type double patenting. As this is a provisional rejection and no patent has matured in either case, it is premature to provide a terminal disclaimer or otherwise substantively address this provisional rejection. In the event that one or the other application matures into a patent, Applicant will address this issue at that time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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Attorney Docket: 1104-032

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